REMARKS

By this Amendment, claims 1 and 10 have been amended. Accordingly, 1-13 are pending in the present application.

Claims 1-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the prior art of Fig. 11 in view of Warneke et al. Applicants respectfully traverse this rejection.

Among the limitations of independent claim 1 which are neither disclosed nor suggested in the prior art of record is a high-frequency circuit board unit having a semiconductor device which includes a semiconductor device having a non-high-frequency signal terminal which is "not connected to any terminal electrode on said first surface of said circuit board so as to be isolated from receipt of a surge voltage". Likewise, independent claim 10 is directed to a manufacturing method for a high-frequency circuit board wherein "said non-high-frequency signal terminal is not connected to any terminal electrode on said second surface of said circuit board so as to be is isolated from receipt of a surge voltage."

The admitted prior art of Fig. 11 specifically teaches that the non-high frequency signal terminal 8b is connected to a terminal electrode 5a on a lower surface of the circuit board 3. Thus, as described on page 2, lines 10-16, the non-high frequency signal terminal 8b of Fig. 11 is not isolated from receipt of a surge voltage.

Warneke et al. does not remedy this deficiency in the prior art of Fig. 11. Even if one were to substitute the filter of Warneke et al. for the filter 15 shown in prior art Fig. 11, the non-high-frequency signal terminal 8b of Fig. 11 would still be subject to receipt of a surge voltage (i.e., a high-frequency signal) through the terminal electrode 5a located on the lower surface of the circuit board 3. There is simply no teaching or suggestion in either

Application No.: 09/974,668 Docket No.: M1071.1451/P1451

of the cited references to remove the connection between the non-high frequency signal terminal 8b and the terminal electrode 5a so as to be isolated from receipt of a surge voltage. Accordingly, it is respected submitted that independent claims 1 and 10 patentably distinguish over the art of record.

Claims 2 through 9 depend either directly or indirectly from independent claim 1 and include all of the limitations found therein. Claims 11 through 13 depend either directly or indirectly from independent claim 10 and include all of the limitations found therein. Each of these dependent claims include additional limitations which, in combination with the limitations of the claims from which they depend, are neither disclosed nor suggested in the prior art of record. Accordingly, claims 2-9 and 11-13 are likewise patentable.

In view of the foregoing, favorable consideration of the amendments to claims 1 and 10, and allowance of the present application with claims 1-13 is respectfully and earnestly solicited.

Dated: June 21, 2004

Respectfully submitted,

Richard LaCava

Registration No.: 41,135

DICKSTEIN SHAPIRO MORIN &

By Michael Stalana

OSHINSKY LLP

1177 Avenue of the Americas

41st Floor

New York, New York 10036-2714

(212) 835-1400

Attorney for Applicant